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Priceline.com dismisses patent challenge

Last modified: January 13, 1999, 9:20 PM PST

By Tim Clark
Staff Writer, CNET News.com

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update Priceline.com faces a challenge to its key patent from an entrepreneur who claims that he developed the technology first.

The dispute takes on added significance because Priceline.com filed for an initial public offering on December 23, stating its intention to sell up to \$115 million in common stock. But the Stamford, Connecticut, company disclosed the patent challenge in its filing with the Security and Exchange Commission.

Priceline filed its patent application in September 1996 and received a so-called "business process" patent in August 1998, protecting its "name your own price" for purchasing of goods and services through the Internet. The patent is number 5,794,207.

Priceline says the patent covers its basic procedures of doing business: Consumers can name how much they'll pay for a plane ticket on a specific day between two cities, and Priceline.com lets major airlines say whether they'll sell the seat at that price--within an hour.

But Thomas G. Woolston's MercExchange applied for its patent in November 1995. His patent, 5,845,265, states it is a way to allow bargaining after purchase of used or collectible goods by computer "in an electronic market."

"We're trying to prevent a competitor from ripping out off our intellectual property," said Woolston, of Arlington, Virginia, a patent attorney whose fledgling company won a similar patent on December 1. Because Woolston filed 16 months earlier than Priceline.com did, he contends his patent should take precedence.

Woolston contends part of his patent covers the same way of doing business that Priceline patented, a claim Priceline denies.

"We have reviewed the application and see no reasonable basis for his charge," Priceline.com spokesman Brian Ek said.

Woolston says he's not trying to derail Priceline's IPO. "I didn't want interfere with these guys in any way," he said.

Priceline's Ek declined to comment on how the patent dispute might

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affect the public offering, citing SEC rules in force after an IPO. Priceline's SEC filing addresses the dispute: "[We] believe that there is no reasonable basis for the United States Patent and Trademark Office to declare an interference action," the filing states, using the legal term for the patent challenge.

Should the patent office ruled against Priceline, the IPO filing states, it "could prevent us from exploiting our business model through the Priceline.com service or require us to obtain licenses from one or more other patent holders at a cost which may adversely affect our business."

Woolston said he has negotiated with Priceline for several months, proposing both joint development and a cross-licensing of patents, to no avail. On the same day his patent was issued, he filed a formal challenge to Priceline.com's patent with the U.S. Patent and Trademark Office, claiming priority because his application was filed first.

The patent office can take years to rule in such cases, so the validity of Priceline.com's patent may remain up in the air for some time.

Such challenges to patent claims are not uncommon, but Woolston's takes on special significance in light of flurry of recent patents for Internet commerce inventions.

In March 1998, for example, Open Market announced it had won patents on secure online payments and shopping carts, commonly used in e-commerce software.

CyberGold in August won a patent on pay-per-view ads, while in June Netcentives won a patent on using frequent flier miles for online purchases.

Both NetDelivery and V-Cast last year won patents on aspects of "push" technology.

However, none of those patent-holders have announced deals to license their patented technology to other companies. And none have announced enforcement actions against infringers.

Monday, the U.S. Supreme Court declined to review an appeals court ruling that granted mathematical formulas used in computer software equal patent status with other products and processes.

Priceline.com, which has spent heavily in both online and offline advertising to build its brand name, has indicated it will expand its service to mortgages this year, and it is testing its system for buying new cars in the New York area.

Woolston said his firm exists largely as a business plan that he has circulated to investors for several years to get the venture off the ground.

"I'm looking to partner with an existing Internet company, but it's hard to tell," he said, noting that other options include licensing his patent to other companies or launching his own startup.

"Our focus has been to open a successful business, not to litigate, but we'll play the game whatever way it's played," Woolston said.

Bloomberg contributed to this report.

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Priceline: A Net Monopoly No Longer?

Micr soft is challenging its patent on Web auctions

Nothing thrills investors quite like a legal monopoly. That's one reason why priceline.com Inc. (PCLN) (page EB 30), with a broad patent on a method of auctioning goods and services on the Internet, rocketed up to a market value of \$24 billion last April after only a year in business. The Stamford (Conn.) company's business model--letting consumers name their own prices for products such as airline tickets and hotel rooms in a variation of the "reverse auction"--promised to revolutionize the way people buy automobiles, mortgages, and dozens of other products.

And priceline.com has certainly gotten off to a stunning start. For the quarter ended June 30, revenues leaped 225%, to \$111.6, from the previous quarter. But that was before the company had to meet the first major challenge to the patented techniques at the core of the company's business. On Sept. 8, Microsoft Corp. (MSFT) --apparently undaunted by priceline.com's vaunted patent protection--announced plans to offer reverse auctions of hotel rooms on Expedia, its Web travel site. Investors, who shrugged off earlier legal challenges, suddenly got scared Microsoft might wipe out priceline.com's head start. Priceline.com shares fell to 55 5/8 on Sept. 13, 67% off their high, before rebounding to 60 on Sept. 15 after priceline.com announced it had sold a record 50,000 airline seats in one week.

Were investors overreacting? Will priceline.com find itself pecked to death by clones, despite its patent? How well the priceline.com patent holds up could very well determine the answers. While the law allows companies to get patents on methods of doing business, intellectual property experts are increasingly skeptical that priceline.com's will hold up in court. Why? Because reverse auctions existed long before the Internet, and just transferring a selling technique to the Web does not necessarily constitute a novel invention, they argue. "I just don't see it standing up," says Greg Aharonian, editor of the Internet Patent News Service.

Priceline.com and Microsoft are mum about any potential legal conflict, but investors are clearly worried that the auction patent is vulnerable. "It's only the patent that is holding the barbarians at the gate," says James McQuivey, senior analyst at Forrester Research in Cambridge, Mass. "If not for the patent, what would priceline have to stand on?"

The company says that's nonsense. Any challenger will have to provide "clear and convincing" evidence that the U.S. Patent & Trademark Office made a mistake--a

tough standard to meet. "Priceline has always had competitors," says founder Jay S. Walker. "What we haven't had is copycats."

TOUGH FIGHT. But if Walker feels so confident about the patent's validity, why has the company not taken on Microsoft? One reason, says New York intellectual property attorney Barry Rein, may be that the company could have a far tougher time proving its patent in court than it had at the PTO. For "a billion dollar market, [competitors] would turn over rocks to find" legal precedents invalidating the patent, he says.

Meanwhile, Walker is fighting a public relations battle to allay investor concerns. After months of boasting about his powerful patent, Walker is now trying to convince stockholders that the patent is less essential to the company's well-being. "What makes priceline successful is not one element," he says.

Still, the idea that Walker had a lock on the reverse-auction concept for e-commerce is what set priceline.com apart. Without it, it's just another online retailer. And when it comes to selling travel on the Net--84% of priceline's business--the company still trails some nonauction sites, such as Travelocity, which offer advice about hotels and sightseeing. If competitors now feel free to poach the reverse-auction concept, priceline's will be just one of the crowd. That's not nearly as appealing to investors as a monopoly.

By Mike France in New York, with Timothy J. Mullaney in New York and Diane Brady in Greenwich

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The case took a strange twist after San Francisco, California-based firm Marketel International came forward to dispute the validity and ownership of Priceline's patent. In court documents, Marketel claimed that it had developed the buyer-driven auction model before Priceline and had shared the idea with Walker years previously under a nondisclosure agreement.

Based on the information, Expedia sought to have the patent infringement suit brought by Priceline thrown out, arguing that the court must first determine the rightful owner of the patent before allowing the case to proceed.

Market Reacts

Shares of Priceline's battered stock rose on news of the settlement.

On Wednesday morning, it was up 13 cents, or 7.18 percent, to \$1.94. Before the opening bell, shares had climbed 29 cents to hit \$2.10. **ECT**

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TECH STOCKS

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TECH STOCKS SECTION

Priceline, Expedia End Patent Flap



By Clare Saliba
E-Commerce Times
January 10, 2001

The suits filed by Priceline started on an aggressive note and were not expected to be settled.

Priceline.com (Nasdaq: PCLN) has agreed to settle two patent infringement lawsuits it filed against Internet travel competitor Expedia (Nasdaq: EXPE) and Microsoft Corp., according to a joint statement released by the companies Tuesday.

The lawsuits, which were filed in October 1999 in a U.S. district court in Connecticut, alleged that Expedia and its then-parent Microsoft had infringed on a U.S. patent held by Priceline covering its reverse auction model. At issue were Expedia's "Price Matcher" services, which allow customers to place bids on unsold airline tickets and hotel rooms.

As part of the settlement, Expedia will be able to continue offering the services, but will pay royalties to Priceline. Both companies said that they do not expect the deal to have a "material impact" on their respective businesses. Additional details about the agreement are being kept confidential.

"We believe this settlement is in the best interests of our companies," said the companies in a brief statement. "This settlement resolves all legal issues between the parties and allows us to move forward."

Accusations Fly

Although many copyright and patent lawsuits are resolved behind closed doors, the suits filed by Priceline started on an aggressive note and were not expected to be settled.

Priceline not only accused Expedia of infringing on its patent, but also of violating state laws barring unfair trade practices. Priceline also alleged that Microsoft had poached the disputed technology during a series of confidential merger meetings before Priceline launched its initial public offering.

However, according to the suits, the talks between the two firms went sour. During one of those meetings, Priceline alleges, Microsoft's Bill Gates told Priceline founder Jay Walker that Gates did not acknowledge the validity of the patent claims and said that Priceline would have to stand in line if it wanted to sue Microsoft and Expedia for infringement.

Within months, Priceline filed its suits, while Expedia introduced its "Price Matcher" services without waiting for the case against it to be resolved.

Strange Twist

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					Jun 18, 2001		
					Jun 20, 2001		
					Jun 21, 2001		
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[Nov 07, 2001](#)
[Nov 08, 2001](#)
[Nov 09, 2001](#)
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[Nov 11, 2001](#)
[Nov 12, 2001](#)
[Nov 13, 2001](#)
[Nov 14, 2001](#)
[Nov 15, 2001](#)
[Nov 16, 2001](#)
[Nov 17, 2001](#)
[Nov 18, 2001](#)
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[Nov 20, 2001](#)
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[Nov 22, 2001](#)
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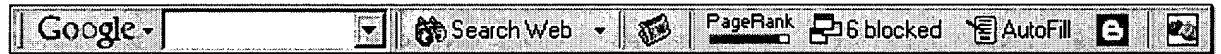
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